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10/002,977	11/14/2001	David R. Flores	STR4.PAU.02	5837

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EXAMINER
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STERRETT, JONATHAN G

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/002,977	Applicant(s) FLORES ET AL.	
	Examiner Jonathan G. Sterrett	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Summary*

1. This **Final Office Action** is responsive to the amendment filed June 30, 2006. **Claims 1-9** are pending in the application.

### *Response to Amendments*

2. The objections to Claims 8, 9 and 14-16 are withdrawn. The rejections of claims 10-21 are moot in view of the cancellation of claims 10-21.

### *Response to Arguments*

3. Applicant's arguments filed on June 30, 2006 with respect to **Claims 1-9** have been fully considered but are not persuasive.

4. The applicant argues that the application meets 35 USC 101 statutory requirements because the invention provides tangible results.

The examiner respectfully disagrees.

The claims as they currently now stand do not represent statutory subject matter because the results that would be provided by the claims do not represent a concrete result. Furthermore, the claims as they now stand do not provide a useful result (i.e. a real world application that provides utility) because the layers of the strategy engine, as is currently claimed, do not provide for a result that is useful. The claims do not represent a result that is concrete, because one of ordinary skill in the art would find that the results provided by the claims are not

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substantially repeatable. While the claims are embodied in a computer readable medium (i.e. represent more than an abstract idea), they do not produce a result that is useful and concrete. Therefore, the claims are non-statutory under 35 USC 101.

The examiner notes that in the arguments, the applicant sets forth the merits of the invention as provided in the affidavits. The applicant states that the software system using a predefined, concrete set of inputs relating to a current and desired future state of the organization. The applicant further argues that the software translates these concepts into “phased, definable business strategies, initiatives, projects and quantified performance goals”. The invention is described as a ‘repeatable process’. The examiner suggests incorporating these features of the invention into the claims to overcome the 101 rejections. The applicant describes a process or a method in his arguments, however the invention, as it is currently claimed, does not recite predefined, specific inputs into a system, a series of clearly defined, positively recited processing steps, and an outcome that is either useful or concrete, as required by 35 USC 101.

5. The applicant argues on page 7 that McGrath does not include a vision of where the company wants to go in a top strategy layer.

The examiner respectfully disagrees.

On page 102 of McGrath’s PACE book, is a strategy pyramid where the top layer is titled “Product Strategy Vision”. On page 102 para 2, McGrath states “Product Strategy provides a road map where product development is going”.

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On page 103 para 2, the text further cites that the vision for product strategy provides for where the company is going (In fact, the three elements taught according to McGrath are "Where are we going? How are we going to get there? And Why will we be successful").

6. The applicant argues on page 7 that McGrath's definition for strategy platform elements have a different meaning than those claimed. The applicant further argues that these strategy platform elements are "strategic concepts" where McGrath's platform elements are technical elements.

The examiner respectfully disagrees.

First, the applicant does not provide as such a special definition in the specification laying out that platform elements are explicitly defined as "strategic concepts". Even so, the use of platform elements in a technical sense, in fact, are strategic concepts in that their arrangement to make up a platform is done to address a strategic need. The fact that there is a lower level technical interoperability associated with technical platform elements does not obliterate that they are strategic from a larger perspective. For example, it is well known that the Chrysler Corporation used the K-car chassis in the 1980's to spawn a number of individual model lines. Probably the most famous of these was the Dodge Caravan, a successful minivan. The underlying chassis components (e.g. engine, transmission, suspension) had technical requirements for interoperability (because they had to fit and work together), but they also were platform elements in a larger, strategic sense. This is due to their providing a number of models to

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be introduced from common elements.

7. The applicant argues on page 8 with respect to Claim 1, that McGrath does not teach the combination of the organization's current and future desired state determine the creation and/or selection of value platforms to create organizational change.

The examiner respectfully disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the combination of the organization's current and future desired state determine the creation and/or selection of value platforms to create organizational change) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. The applicant argues on page 9 with respect to Claim 3, that McGrath's definition of future requirements does not include making possible the creation of a value platform and enable the installation, creation or capture of a value platform.

The examiner respectfully disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which

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applicant relies (i.e., making possible the creation of a value platform and enable the installation, creation or capture of a value platform) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

9. The applicant argues on page 9 with respect to Claim 4, that McGrath's process for developing strategy is product centric, and does not incorporate the scope of enterprise business planning as does the proposed art because it does not include a broad range of potential requirement types (i.e. human resources, facilities, real estate, specific alliance relationships).

The examiner respectfully disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a broad range of potential requirement types (i.e. human resources, facilities, real estate, specific alliance relationships) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. The applicant argues on page 10 with respect to Claim 5, that McGrath's platform strategy elements (McGrath's product platforms as an intermediate layer, as is cited) are not the sum total of all (at least 2) defined, described,

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phased and integrated value platforms, organized sequentially to achieve an organization's future desired state.

The examiner respectfully disagrees

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a broad range of potential requirement types (i.e. the sum total of all (at least 2) defined, described, phased and integrated value platforms, organized sequentially to achieve an organization's future desired state) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. The applicant argues on page 10 with respect to Claim 6, that McGrath's technical elements to be integrated into a broad range of products are not "value platform requirements that refer to a broad range of necessities (i.e. human resources, facilities, real estate, specific alliance relationships) that are captured and displayed to show definable gaps in a strategic building block.

The examiner respectfully disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a broad range of potential requirement types (i.e. value platform requirements that refer to a broad range of necessities (i.e. human resources, facilities, real estate, specific alliance relationships) that are captured and



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displayed to show definable gaps in a strategic building block) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. The applicant argues on page 11 with respect to Claim 7, that McGrath's product platform is not a strategic concept such as "world class training support".

The examiner respectfully disagrees.

The product platform as taught by McGrath is as much a strategic concept as is the claimed invention, in that a product platform is a strategic concept for getting products to market while leveraging reuse of the underlying product development activities. The term 'value platform', 'value creation opportunity' is not defined in the specification in such a way as to preclude the teachings of McGrath as being a 'strategy platform'.

13. The applicant argues on page 11 with respect to Claim 8, that McGrath's does not teach the claimed limitations of displaying the phases over the time frame of the strategy.

The examiner respectfully disagrees.

McGrath teaches that product line planning is definitely a phased activity. The illustrations of figure 7-2 show a time phased example of a product line strategy by market segmentation. The curves show the volume ramp up of the various products to be introduced according to the schedule illustrated by year

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(see x-axis year notations).

***Claim Rejections - 35 USC § 112***

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **Claim 1**, the preamble describes a system with an engine. The remaining limitations describe three layers of the engine. It is not clear how the 3 layers operate together to form an engine in a strategy management system. While the top and bottom layers are integrated with at least one intermediate layer. There is no interaction cited between the 3 layers to provide the functionality of managing a strategy, therefore the claim is indefinite. For the purposes of examination, the examiner assumes that the at least one intermediate layer interacts between the top and bottom layer to integrate and align the strategic direction and the strategy platform requirements.

***Claim Rejections - 35 USC § 101***

16. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

17. **Claims 1-9** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order to be statutory, the claimed invention must produce a useful, concrete, and tangible real-world result. An invention that fails to produce a tangible result is one that involves no more than the manipulation of an abstract idea. In order to be concrete, the result must be substantially repeatable or re-produce the same result. The result is useful when there is a real-world practical application.

**Claim 1** recites three layers in a strategy formulation engine in a system that are adapted to define strategic states, include a plurality of platform requirements, and include a plurality of strategic platforms to achieve the desired future state. These limitations fail on the requirements under 35 USC 101. The layers in the engine are adapted to perform various functions that appear to be subjective, and thus fail the concrete test as the system would not produce a result that is repeatable. Finally, there is no real-world practical application recited and the system is considered to fail the useful test.

Therefore **Claims 1-9** are directed towards a non-statutory subject matter.  
(Examiner Comment: While the inclusion of screenshots from the applicant's software is appreciated by the examiner, the examiner respectfully suggests

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incorporating clear, positively recited claim elements as provided by the software functionality. For example, what method is used to apply the strategic method(s) as embodied in the software to solve a company's particular strategic problem or issue(s)? The examiner suggests including this method in the claims(!)

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. **Claims 1-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over **McGrath**.

McGrath, Michael E; "Setting the PACE in Product Development", Chapter 7 – The Process of Product Strategy, 1996, Elsevier, pp.101-119.

Regarding **Claim 1**, McGrath teaches:

**A top layer of the strategy formulation engine including a definition of an organization's current state and desired future state;**

Page 103 para 2, the strategic vision includes a definition of where a company wants to go (i.e. desired future state) and how it will get there.

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**At least one intermediate layer of the strategy formulation engine including a plurality of strategy platforms to achieve the desired future state; and**

Page 105 para 3, the product platform strategy includes a collection of common technical elements (i.e. a plurality of strategy platforms). The product platform technical elements help the company achieve the desired future state by ensuring a product has the necessary technical elements as per the strategy.

**A bottom layer of the strategy formulation engine including a plurality of strategy platform requirements to achieve the strategy platforms.**

Page 110 para 4, the product line strategy provides for a plurality of requirements to achieve the strategy platforms. The requirements include what specific models will be introduced in line with the higher level platform strategy. The requirements also include when the models will be introduced.

McGrath teaches that the strategic vision is contextual and that it defines where a company is going to go, from a strategic position standpoint. McGrath does not teach a specific definition of where a company is in relation to where it is going. However, it is old and well known in the art of strategic management for a company to define where it is (i.e. current state), from a strategic competitive standpoint, as a step to better understanding how it is going to get to a desired strategic position. If a company assesses its current state as competitively weak, in a strategic context, then it knows that it has a significant amount of

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achievement to accomplish a superior competitive position.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of McGrath, regarding providing a vision that includes a definition of where a company is going, strategically, to include the step of defining a company's current strategic state, because it would provide a better understanding of the work required to achieve a desired strategic end state.

McGrath does not teach his approach to strategy to be embodied in a computer system into an engine, however, Official Notice is taken that the use of computers to automate processes, including using engines in a system, is old and well known in the art. Computer automation provides the benefits of making the process faster, easier to use and more efficient.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of McGrath, regarding providing an integrated approach to integrating a strategic vision with a platform strategy, to include the step of using a computer system with an engine to operate the strategic process, because it would provide the benefits of making the process faster, easier to use and more efficient.

Regarding **Claim 2**, McGrath teaches:

**wherein the desired future state includes a vision statement and a target date.**

Page 103 para 1, strategic direction includes the vision (i.e. vision statement) – see also para 2, the vision (i.e. vision statement provides the context and direction, including the desired strategic end state).

Page 103 para 1, the vision includes timing (i.e. a target date).

Regarding **Claim 3**, McGrath teaches:

**wherein each strategy platform includes a definition of future requirements that are necessary for the strategy platform to assist in achieving the strategic direction.**

Page 104 para 4, the platform elements provide for requirements (a platform must have the designed technical elements to be a functioning platform and thus assist the platform strategy in achieving the strategic direction.

Regarding **Claim 4**, McGrath teaches:

**wherein the strategy platform requirements may be directly transformed into implementation activities.**

Page 104 para 3, the strategy platform requirements operating through the strategic vision direct product development activities. Platform requirements determine what development teams will work on from a platform element standpoint (i.e. what building blocks do development teams work with) and also how the strategy platform requirements determine product line planning, i.e.

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implementation activities (see page 105 para 3 and page 107 Figure 7-2).

Regarding **Claim 5**, McGrath teaches:

**wherein the at least one intermediate layer includes a plurality of strategy platforms.**

Page 103 para 6, the product platform strategy integrates the strategic direction with the platform requirements (see page 105 para 2 & 3).

Regarding **Claim 6**, McGrath teaches:

**wherein each of the strategy platforms includes at least one of the strategy platform requirements.**

Page 105 para 2 & 3, strategy platforms (i.e. strategic product platforms) include a series of requirements stating what the common technical elements will be that are integrated into a range of products.

Regarding **Claim 7**, McGrath teaches:

**wherein each of the strategy platforms includes at least one value creation opportunity.**

Page 105 para 2 & 3, McGrath's strategic product platforms include at least one value creation opportunity as embodied in various products that go to market utilizing the product platform strategy.

Regarding **Claim 8**, McGrath teaches:



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**A layer dedicated to the capture and display of the phases over the time frame of the strategy.**

Figure 7-1, product line strategy displays the phases of different model introductions over the time frame of the strategy implementation.

Regarding **Claim 9**, McGrath teaches:

**A feature dedicated to the capture and display of the relationships between value platforms.**

Figure 7-2, this graph illustrates the display of the relationships between product (i.e. value) platforms. Note the top "Large High Performance Systems" where the "Platform E Comp" is shown in relation to "Platform N/C-13".

### ***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory

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period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Sterrett whose telephone number is 571-272-6881. The examiner can normally be reached on 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGS 8-21-2006

*Romain J. Jantz*  
Primary Examiner  
Art Unit 3623